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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/095,842	06/11/1998	TAKAYUKI ARAKI	VX961463A-PC	1105

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EXAMINER

SZEKELY, PETER A

ART UNIT

PAPER NUMBER

1714

34

DATE MAILED: 02/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 34

Application Number: 09/095,842  
Filing Date: June 11, 1998  
Appellant(s): ARAKI ET AL.

R. Eugene Varndell, Jr.  
For Appellant

EXAMINER'S ANSWER

MAILED

FEB 20 2003

GROUP 1700

This is in response to the appeal brief filed 12/09/02.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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**(2) Related Appeals and Interferences**

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is deficient because the invention does not include polymerization without the non-fluorine containing surfactant or the higher than 1% level of the fluorine containing surfactant.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 6-17 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

Claims 6-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See page 3, lines 6-12, page 4, lines 13-21 and page 6, lines 25-37.

Claims 6-11 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The non-ionic, non-fluorine containing surfactant is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See page 3, lines 6-12, page 4, lines 13-21 and page 6, lines 25-37.

Claims 12-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention in the specification of "an average particle size of not more than 320.1 nm" and that

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particle size is outside of the limits of the claimed invention. See page 4, lines 7-12 of the specification.

Claims 15-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention of "an average particle size of not more than 196.3 nm" and the 2.0% by weight of fluorine containing surfactant is outside the limits of the claimed invention. See page 4, lines 7-12 of the specification.

**(11) Response to Argument**

The cited parts of appellants' specification (page 3, lines 6-12, page 4, lines 13-21 and page 6, lines 25-37) make it clear that a two part surfactant system is needed to yield a particle size of not more than 200 nm, when not more than 1% by weight of fluorinated surfactant is used. The first citation is in the part where the prior art is discussed, but it is not about the prior art. "Usually" is used in both on page 3 and page 6, but the "unusual" situation is not described anywhere in the specification. If something "usually cannot be made", one would expect a detailed description of an "unusual" process. However, there is no description and no Illustrative Example in the instant specification describing the unusual process, which would yield the claimed product without the second surfactant. As a matter of fact, Comparative Examples 1-4, all of which use only one surfactant and a surfactant level of not more than 1% by weight, all report particle sizes ranging from 231.7-320.1 nm. Comparative Example 5,

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which shows a particle size of less than 200 nm, uses 2% by weight of surfactant. One of ordinary skill in the art perusing this data would not have any idea how to make the claimed invention and attempts to achieve it would definitely necessitate undue experimentation. The Declaration of Mr. Tsuda has no probative value; because he used 2% by weight of surfactant to make aqueous dispersion (A) and aqueous dispersion (B) is the result of the dilution and re-concentration of dispersion (A). Furthermore the Declaration is not a part of the original specification and there is no description of this two-step process in the specification. Even if we were to accept the Declaration as proving that the claimed product can be made without using two surfactants, one reading the specification still would not know how to avoid the pitfalls of Comparative Examples 1-4. Claims 12-14 claim a product, which is not described in the specification. The 320.1 nm particle is shown only in Comparative Example 4 and is not part of the invention because it has a particle size of more than 200 nm. The phrase "not more than 320.1 nm" cannot be found in the original description. The Disclosure of the Invention, on page 4, lines 7-12, clearly restricts the invention to particle sizes of not more than 200 nm. Claims 15-17 also claim a product, which is not describe in the specification. The 196.3 nm particle is shown only in Comparative Example 5 and is not part of the invention because it uses 2% surfactant by weight. The phrase "not more than 196.3 nm" cannot be found in the original description. The Disclosure of the Invention on page 4, lines 7-12, clearly restricts the invention to a fluorinated surfactant level of not more than 1% by weight.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Peter Szekely  
Primary Examiner  
Art Unit 1714

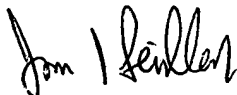


P.S.  
February 19, 2003

Conferees

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